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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,188	08/28/2003	Ronald L. Mahany	14426US02	8344
23446	7590	09/16/2005	EXAMINER	
MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			TON, DANG T	
			ART UNIT	PAPER NUMBER
			2666	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/651,148

Applicant(s)

THOEDE ET AL.

Examiner

DANG T TON

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. The disclosure is objected to because of the following informalities:

Applicant should provide an updated status of all copending applications recited in the specification.

Appropriate correction is required.

2b. Claims 18-56 are objected to under 37 C.F.R. 1.75 because of the following formalities:

In claims 18, 24, 34, 38, 44, 53, and 56, the terms "adapted to" or "capable of" are not positively recited claimed limitation. It is suggested applicants remove the terms.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

Art Unit: 2666

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,654,378. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following formalities:

For claims 18-56, the claims 1-20 of U.S. Patent No. 6,654,378 disclose  
a communication system comprising: a first wireless network; a mobile service vehicle, the mobile service vehicle having a

Art Unit: 2666

power supply associated therewith; a plurality of network devices wirelessly communicating with one another to form a second wireless network operating as a subnetwork in the first wireless network; and at least a first network device of the plurality of network devices being adapted to receive power from the power supply associated with the mobile service vehicle, and participating on the first wireless network to provide access for a second network device of the plurality of network devices to the first wireless network;

wherein the first network device of the plurality of network devices comprising an access server;

wherein the access server is adapted to participate as a slave device in the first wireless network pursuant to a first communication protocol and as a master device in the second wireless network pursuant to a second communication protocol;

wherein the access server resolves conflicts between the first and second communication protocols;

Art Unit: 2666

wherein at least the first network device of the plurality of network devices participates as a slave device in the first wireless network pursuant to a first communication protocol and as a master device in the second wireless network pursuant to a second communication protocol;

wherein one of the plurality of network devices other than the first network device of the plurality of network devices, participates as a slave device in the first wireless network pursuant to a first communication protocol and as a slave device in the second wireless network pursuant to a second communication protocol;

a wireless premises network; a wireless peripheral subnetwork comprising a plurality of network devices, each having a relatively shorter range than the wireless premises network; a mobile network device capable of communicating with the wireless premises network and the wireless peripheral subnetwork; and a mobile service vehicle having a power supply associated with the vehicle, the mobile service vehicle configured to receive the mobile network device in mounting relation therewith, thereby providing the mobile network device access to the power supply associated with

the vehicle;

wherein the mobile network device participates on the wireless peripheral subnetwork when the mobile network device is within the relatively shorter range of the wireless peripheral subnetwork;

further comprising a peripheral device disposed on the mobile service vehicle which is adapted to participate in the wireless peripheral subnetwork;

wherein the mobile network device participates as a slave device in the wireless premises network pursuant to a first communication protocol while participating as a master device in the wireless peripheral subnetwork pursuant to a second communication protocol;

wherein the mobile network device resolves conflicts between the first and second communication protocols;

wherein the mobile network device enters a state of low power consumption when not communicating with either the wireless premises network or the wireless peripheral subnetwork;

with the wireless premises network having a first plurality of network devices and the wireless peripheral subnetwork having a second plurality of network devices such that when within range of one of the second plurality of network devices, the mobile network device participates as a master device in the wireless peripheral subnetwork and when within range of one of the first plurality of network devices, the mobile network device participates as a slave device in the wireless premises network;

further comprising: a network device independent of the mobile network device; the network device identifying a range value indicative of the distance between the network device and the mobile network device; the network device transmitting the range value to the mobile network device; and the mobile network device, upon receipt of the range value, identifying an appropriate data rate for subsequent transmission to the network device;

further comprising: a network device independent of the mobile network device; the network device identifying a range value indicative of the distance between the network device



Art Unit: 2666

and the mobile network device; and the network device indicating to the mobile network device an appropriate rate for subsequent data transmission to the network device;

further comprising: a premises network device independent of the mobile network device; the premises network device identifying a range value indicative of the distance between the premises network device and the mobile network device; the premises network device transmitting the range value to the mobile network device; the mobile network device identifying battery parameter information; and the mobile network device, based on the received range value and battery parameter information, identifying an appropriate data rate and power level for subsequent transmission to the premises network device;

a wireless premises network; a mobile network device used to conclude customer purchase transactions and capable of communicating with the wireless premises network; a mobile service vehicle comprising a power supply associated with the vehicle and a peripheral device coupled to the power supply associated with the vehicle, wherein the mobile network device and the peripheral device communicate wirelessly; and the

Art Unit: 2666

mobile service vehicle being configured to receive the mobile network device in mounting relation therewith, thereby providing the mobile network device access to the power supply associated with the vehicle;

wherein the mobile network device wirelessly communicates using lower power transmissions to the peripheral device, and using higher power transmissions when communicating with the wireless premises network;

wherein the mobile network device conducts wireless communication at selected power levels; and

a first wireless network; a mobile service vehicle, the mobile service vehicle having a battery power supply; a plurality of network data communication devices together forming a second wireless network operating as a subnetwork in the first wireless network; and at least a first data communication network device of the plurality of data communication network devices participating on the first wireless network to provide access for a second data communication network device of the plurality of data communication network devices to the first wireless network.

Note: see claims 1-20 of the patent number 6,654,378.

Applicant's claims 18-56 merely broaden the scope of claims 1-20 of the patent number 6,654,378 by eliminating the terms " a mobile service" from the claims 1,7, and 20 of the patent number 6,654,378 ; and "wireless peripheral subnetwork comprising a plurality of network devices, each having a relatively shorter range than the wireless premises network" from the claim 7 of the patent. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not need would be obvious to one skilled in the art.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the

Art Unit: 2666

invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 38,39,40,41,53, and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Meier ( 5,504,746).

Note: the terms following the word " adapted" recited in the claims are not considered the claimed limitation since the word " adapted" is not positively recited claimed limitation. It is suggested applicant to remove the word " adapted" from the claims.

For the claims 38,39,40,41, and 56, Meier disclose a radio frequency local area network comprising

at least one wireless transceiver (see box 120 in figure 1),  
the network device;

wherein the network device comprises an access server (see box 10 in figure 1).

Art Unit: 2666

wherein the access server resolves conflicts between the first and second communication protocols (see column 9 lines 57-67); and

the data communication network device participating on the first wireless network to provide access to the first network for a second data communication device on the second wireless network (see column 2 lines 34-39).

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 44,45 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meier in view of Fischer (5,502,726).

For 44,45, and 53, Meier disclose all the subject matter of the claimed invention with the exception of a power supply associated with the vehicle in a communications network. Fisher from the same or similar fields of endeavor teaches a provision of the power supply associated with the vehicle (see box 234 and 232 in figure 2). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to use power supply associated with the vehicle as taught by Fisher in the communications network of Meier

The power supply associated with the vehicle can be implemented/modified into the network of Meier by connecting power supply to Meier's network. The motivation for using power supply associated with the vehicle being that it provides the power to the system.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mahany et al. (5,790,536 ; 5,657,317 ; 5,740,366 ; 5,555,276 ; 5,657,317) and Kubler et al. (5,726,984) are all cited to show systems which are considered pertinent to the claimed invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANG T TON whose telephone number is 571-272-3171. The examiner can normally be reached on MON-WED, 5:30 AM-6:00 PM and Thur 5:30-9:30 A.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2666

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Ton



DANG TON  
PRIMARY EXAMINER